



JAN 11 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

Micheline Gravelle  
BERESKIN & PARR  
Box 401, 40 King Street West  
Toronto, Ontario  
Canada M5H 3Y2

In re Application of  
WARRINGTON, R. C. *et al*  
Application No.: 09/600,125  
PCT No.: PCT/CA99/00005  
Int. Filing Date: 13 January 1999  
Priority Date: 13 January 1998  
Attorney Docket No.: 10242-32  
For: COMPOSITION CONTAINING  
PROPARGYLAMINE FOR  
ENHANCING CANCER THERAPY

DECISION

This is a decision on applicants' "Renewed Request Under 37 CFR 1.42" filed 16 October 2001.

**BACKGROUND**

On 10 July 2001, a decision dismissing applicants' request under 37 CFR 1.42 was mailed because the declaration did not list the residences and mailing addresses of the legal representatives of deceased co-inventor, I. Alick Paterson as required by 37 CFR 1.497(b)(2).

On 16 October 2001, applicants submitted the instant renewed request which was accompanied by, *inter alia*, an executed declaration and a two-month extension and a \$400.00 extension fee.

**DISCUSSION**

The decision dated 10 July 2001 stated that the declaration submitted 30 April 2001 was not in compliance with 37 CFR 1.497 because the residences and mailing addresses of the legal representatives, Brenda Kennedy and Kevin Rogers were not listed. After further consideration, this statement has been determined to be erroneous.

The legal representative in this case is the Canada Trust Company. Therefore, the citizenship, residence and mailing address of the Canada Trust Company is required on the declaration, not that of Ms. Kennedy or Mr. Rogers. See 37 CFR 1.497(b)(2).

However, a further review of the declaration filed 30 April 2000 shows that it was still not in compliance with 37 CFR 1.497. The declaration did not denote the citizenship of the Canada Trust Company. The statement "that it is a Canadian Company" listed on the top portion of the "Added Page to Combined Declaration . . ." is not sufficient. 37 CFR 1.497(b)(2) specifically requires that the citizenship of the legal representative be on the declaration. Further, section 605.01 of the Manual of Patent Examining Procedure states that "[w]here an applicant is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement." No such statement was filed.

Moreover, the residence of the legal representative was listed, but the declaration did not indicate whether that was also the mailing address of the Canada Trust Company. Both the residence and mailing address of the legal representative must be listed pursuant to 37 CFR 1.497(b)(2).

The declaration filed with the instant petition is also not in compliance with 37 CFR 1.497 due largely to counsel's attempt to follow the instructions contained in the decision dated 10 July 2001. We regret any inconvenience this may have caused.


It is also noted that the citizenship of the deceased co-inventor, I. Alick Paterson is listed as the United Kingdom on the 30 April 2001 declaration, while the citizenship of the deceased co-inventor is listed as Canadian in the declaration submitted in the instant response. Please verify whether the citizenship of the deceased co-inventor is Canadian or British.

### **CONCLUSION**

Applicants' request Under 37 CFR 1.42 is **DISMISSED** without prejudice.

If reconsideration of this decision is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.42". Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

  
Boris Milef  
PCT Legal Examiner  
PCT Legal Office

  
James Thomson  
Attorney Advisor  
PCT Legal Office

Tel.: (703) 308-6457